UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,280	01/28/2004	Stephen J. Lee	547-135	7569

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EXAMINER
BAYOU, YONAS A

ART UNIT	PAPER NUMBER
2109	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/765,280	LEE ET AL.
	Examiner	Art Unit	
	Yonas Bayou	2109	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _1/28/04_.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-13_ is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-13_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _28 January 2004_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☒ All   b) ☐ Some * c) ☐ None of:

        1. ☒ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by

Edelman US Patent No 6,857067 (hereinafter Edelman).

Referring to claims 1, 5 and 10, Edelman teaches a computer-implemented

method for controlling execution of application software by a computer terminal, at least

a first portion of the application software being loaded into a data storage medium of the

computer terminal, said method comprising:

a) when it is intended to execute the application software, enabling the computer

terminal to detect presence of an electronic key that is connected thereto **[column 7,**

lines 47-55; fig. 1, the client program (software) accesses the smart card 120

(electronics key) connected to the client computer 100 (computer terminal)];

b) inhibiting execution of the application software upon detection by the computer terminal that the electronic key is disconnected therefrom **[column 7, lines 6-12; column 12, lines 42-49;** to execute the application software, it is obvious that client computer 100 should communicate with licensing medium/the smart card 120];

c) upon detection by the computer terminal that the electronic key is connected thereto, enabling the computer terminal to verify presence of a software registration code in each of the computer terminal and the electronic key **[column 4, lines 5-9;** the electronic device (the computer terminal) verify the validity of the licensing medium (electronics key) which is inherently stores a license data (a software registration code)];

d) upon detection by the computer terminal that at least one of the computer terminal and the electronic key does not have a software registration code stored therein, enabling the computer terminal to initiate a registration procedure with a remote server so as to obtain the software registration code therefrom and so as to store the software registration code obtained from the remote server in each of the computer terminal and the electronic key **[column 2, lines 16-28; column 6, lines 15-16; column 9, lines 1-12; fig. 6** and once the software has been installed, the user has to register the installed software with the registration authority (a remote server) which is inherently obtain the software registration code if the computer terminal and the electronic key (smart card) does not have a software registration code];

e) upon detection by the computer terminal that each of the computer terminal

and the electronic key has a software registration code stored therein, enabling the

computer terminal to verify if the software registration code stored in the computer

terminal matches that stored in the electronic key **[column 2, lines 16-28; column 7,**

lines 6-12; column 9, lines 12-19; the licensing medium 120 (electronic key) and the

client program (computer terminal) communicate to verify that the user is authorized to

execute the software which is inherently, if a software registration code stored in the

computer terminal and in the electronic key matches, enables the user to use the

software];

f) enabling further execution of the application software by the computer terminal

upon detection thereby that the software registration code stored in the computer

terminal matches that stored in the electronic key **[column 6, line 61- column 7, line6;**

column 9, lines 1-27; when the software registration code stored in the computer

terminal matches/compares that stored in the electronic key (smart card), enabling

further execution of the software (code/license issued for the application software). For

example, in terms of time limit to use the software]; and

g) aborting further execution of the application software by the computer terminal

upon detection thereby that the software registration code stored in the computer

terminal does not match that stored in the electronic key **[column 8, lines 46-56;**

column 13, lines 1-11; stop execution of software if it is determined that the software

has been tampered or failed verification of a valid smart card (electronic key with

software registration code) which is inherently aborting execution of software if the

software registration code stored in the computer terminal does not match that stored in the electronic key].

Referring to claims 2 and 12, Edelman teaches a computer-implemented method, the data storage medium of the computer terminal that has the first portion of the application software loaded therein being a hard disk, wherein said step d) includes the sub-step of:

enabling the computer terminal to transmit user information to the remote server, the user information including at least one of a software serial code associated with the application software, a key serial code associated with the electronic key, and a disk serial number associated with the hard disk **[column 9, lines 40-60**; the registration information (the user information) sent to the registration authority (the remote server) includes the unique identifier of the software and hard disk to be registered. The identifier may be composed of a serial number, a serial code and a password or pass phrase to prevent an unauthorized user].

Referring to claims 3 and 13, Edelman teaches a computer-implemented method, a second portion of the application software being resident in the remote server, wherein said step d) includes:

enabling the computer terminal to download the second portion of the application software from the remote server and to store the second portion of the application software in the electronic key when the software registration code is

obtained from the remote server **[column 5, lines 1-15**; a license manager which

communicates with the electronic device (the computer terminal) and the registration

authority (the remote server) has a second database of verification data(second portion

of the application software) enabling/verifying the license data (software registration

code) stored in the licensing medium (electronic key) when the code is obtained from

the registration authority which is inherently store the software registration code in the

electronic key].

Referring to claim 4, Edelman teaches a computer-implemented method,

wherein, in step f), further execution of the application software is aborted by the

computer terminal upon detection by the computer terminal that the electronic key was

disconnected therefrom **[column 12, lines 42-49; fig. 7**; the smart card (the electronic

key) containing valid license should be inserted to the smart card reader of the client

computer (the computer terminal)].

Referring to claims 6 and 7, Edelman teaches a computer-implemented method,

wherein said step f) includes:

enabling the electronic key to generate a random verification code transmitted to

and stored in the computer terminal in an encrypted and compressed format **[column 9,

lines 19-27; column 12, lines 5-12**; the smart card (the electronic key) generates a

fixed-length code (a random verification code) stores it in the registration authority/on

the card];

upon detection by the electronic key that a verification period corresponding to

the verification code and set by the electronic key has expired, enabling the electronic

key to compare the verification code stored in the computer terminal with that generated

thereby **[column 12, lines 5-12; column 49-67**; the client program which reads the

contents of the smart card compares the generated message digest (code) to the

decrypted message digest];

upon detection by the electronic key of a match between the verification code stored in

the computer terminal and that generated thereby, enabling further execution of the

application software by the computer terminal, and enabling the electronic key to

generate another verification code with a corresponding verification period **[column 9,**

lines 19-27; column 11, lines 29-50; the registration authority compares the message

digest (the verification code) to a corresponding entry in the database (a generated

verification code) to verify that the smart card is valid (equivalent to verification period)].

; and

upon detection by the electronic key that the verification code stored in the

computer terminal does not match that generated thereby, enabling the computer

terminal to initiate the registration procedure with the remote server **[column 11, lines**

36-67; column 12, lines 5-12; upon receiving the smart card data (the electronic key

data), the registration authority (the remote server) verify that the smart card data is

valid (current verification code). After verification, the registration authority generates

new smart card data (initiate the registration procedure) to update the expiration date

and sequence number of the smart card].

Referring to claims 8 and 9, Edelman teaches a computer-implemented method, wherein said step f) includes, when the computer terminal intends to execute the second portion of the application software in the electronic key,

enabling the computer terminal to send data to be processed using the second portion of the application software to the electronic key **[column 4, lines 33-42**; the electronic device (computer terminal) send data (second portion of the application software) to the registration authority for updating/processing license data then provide updated license data to the licensing medium (the electronic key)],

enabling the electronic key to perform calculations associated with the second portion of the application software using the data from the computer terminal **[column 2, lines 28-34; column 2, lines 47-56**; the validity of the code (the second portion of the application software) is determined by using mathematical algorithm (calculation) that are distributed with the software which is inherently the electronic key performs calculations to protect the software from unauthorized users], and

enabling the electronic key to send results of the calculations performed thereby to the computer terminal **[column 2, lines 47-56; column 4, lines 17-26**; the code sequence (calculations performed data) is sent back to the user(the computer terminal) in an encrypted form. The data may be encrypted with a private key associated with registration authority].

Referring to claim 10, Edelman teaches a computer program product comprising

program instructions for causing a computer terminal to perform steps of the computer-implemented method **[column 6, line 61- column 7, line 6 and fig. 1**; a client program (a computer program) installed on the client computer communicates with a licensing medium 120 and the registration authority 110 to execute the electronic data (the application software)].

Conclusion

3.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yonas Bayou whose telephone number is 571-272-7610. The examiner can normally be reached on m-f,7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Del Sole can be reached on 571-272-1130. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yonas Bayou

YB

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PRIMARY EXAMINER